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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/382,372 | 08/24/1999 | JEFFRY JOVAN PHILYAW | PHLY-24738 | 5133 |

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| EXAMINER | |
|---|---|
| KANG, PAUL H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2141 | 19 |

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

P24

| Office Action Summary | Application No | Applicant(s) | |
|---|---|---|---|
| | 09/382,372 | PHILYAW ET AL. | |
| | Examiner | Art Unit | |
| | Paul H Kang | 2141 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *15 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims cited below of copending Application Nos. 09/382,427 (hereafter referred to as '427) and 09/494,956 (hereafter referred to as '956).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1 and 2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,594,705 B1, claims 1-27 of US Pat. No. 6,636,896 B1 and claims 1-18 of US Pat. No. 6,098,106. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the two commonly owned patents.

***Claim Objections***

4. Claim 2 is objected to because of the following informalities: "threat" on line 8 is misspelled. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolzien, US Pat. No. 5,761,606 in view of Hudetz et al., US Pat. No. 5,978,773 and further in view of Reese, US Pat. No. 6,374,237 B1.

6. As to claim 1, Wolzien teaches the invention substantially as claimed. Wolzien teaches receiving at a user's computer at a location on the network an audio signal from a broadcast generated by an advertiser, which audio signal has embedded therein unique coded information (Wolzien, col. 3, lines 25-49);

connecting the user's computer to an advertiser's location in response to extracting the unique coded information from the audio signal, and the advertiser's location being correlated to the unique coded information; extracting the unique coded information from the audio signal in response to the step of receiving (In response to the receipt of the audio/video signal, the system extracts the embedded electronic address for use. Wolzien, col. 3, line 25 – col. 4, line 29 and col. 6, lines 1-58).

However, Wolzien does not specifically teach connecting the user's computer to an advertiser's location without user intervention in response to the step of extracting. In the same field of endeavor, Hudetz teaches a system for automatically connecting a user

to an advertiser's location based on unique coded information retrieved from an input device (Hudetz, abstract and col. 3, line 17 – col. 4, line 30 and col. 9, lines 54-64).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of automatically connecting the user to an advertiser's location, as taught by Hudetz, into the system of Wolzien for the purpose of increasing efficiency and user friendliness.

Wolzien-Hudetz teach the invention substantially as claimed. However, Wolzien-Hudetz do not specifically teach in direct response to the step of connecting causing user profile information of the user to be sent to the advertiser's location over the network, receiving the user profile information at the advertiser's location, and generating advertising information to forward to the user based upon the user profile information being forwarded to the advertiser's location and forwarding this advertising information to the connected user, wherein broadcast of the audio signal causes both a connection to the advertiser's location on the network and a push of user profile information thereto.

In the same field of endeavor, Reese teaches a system for data set selection based upon user profile. Reese teaches transmitting a request that contains a user profile to a server, receiving the profile at the server, and generating the requested information based upon the user's profile (Reese, col. 1, lines 55-63 and col. 4, lines 6-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of content customization based on user profiles, as taught by Reese, into the automatic data retrieval system of Wolzien-Hudetz for the purpose of increasing the quality and relevance of the retrieved data.

***Response to Arguments***

7. Applicant's arguments with respect to claim 1 have been considered but are not deemed to be persuasive. The Applicant argued in substance that:

a. "Even with this combination [of Wolzien and Hudetz], there is no disclosure in either of these reference to suggest or provide any motivation for sending profile information to the remote location once connected thereto." Remarks, page 4.

As to point a, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the combination of Wolzien and Hudetz teach an automated system for linking a user to a remote location in response to receiving an audio signal from a broadcast having embedded therein a unique coded information. In the same field of endeavor, Reese teaches improving existing web communications by enabling more efficient data retrieval by providing user profile information. This enables the user to customize and improve the quality of the data retrieved. Therefore, the artisan of ordinary skill in the art at the time the

invention was made, having a system for communicating on the web as taught by Wolzien-Hudetz, would be motivated to improve the efficiency of the data retrieval by incorporating the use of user profile information as taught by Reese. As an example, the system of Wolzien-Hudetz allows a user, upon receiving an address embedded in a video or audio program, to automatically retrieve a commercial message or a news story. With the addition of Reese, however, the user is able to obtain more customized commercial messages or news stories, filtered to his user preferences.

b. "The *Reese* reference has no relation to the operation of an advertiser controlling the access of user profile information through a broadcast through a plurality of user computers." Remarks, page 6, lines 4-6.

As to point b, in response to applicant's argument that the claimed invention is directed to the operation of an advertiser to control the access of user profile information, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Reese teaches automatic transmission of user profile information from a user to a

server. Combined with the teachings of Wolzien-Hudetz, Reese is capable of performing the intended use of the claimed invention, therefore meets the claim.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul H Kang
Examiner
Art Unit 2141